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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,099	02/27/2004	Takuya Kadota	Q80152	5064

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EXAMINER
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NOTE, JANIS L

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/787,099	<b>Applicant(s)</b> KADOTA ET AL.	
	<b>Examiner</b> Janis L. Dote	<b>Art Unit</b> 1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 September 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
- 1. ☒ Certified copies of the priority documents have been received.
  - 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. The examiner acknowledges the amendments to claims 1, 3, 4, and 7 set forth in the amendment filed on Sep. 28, 2005.

Claims 1-7 are pending.

The substitute specification filed on Sep. 28, 2005, has been entered.

The examiner notes that the originally filed specification provides antecedent basis for the block polyester broadly recited in instant claims 1 and 4 at page 31, lines 12-13. The originally filed specification at page 31, lines 12-13, states that the "block polyesters may have blocks other than the aforementioned crystalline blocks and amorphous blocks."

2. The replacement drawing sheets filed on Sep. 28, 2005, are acceptable.

3. The objection to the drawings set forth in the office action mailed on Jun. 28, 2005, paragraph 1, has been withdrawn in response to the replacement drawings sheets filed on Sep. 28, 2005.

The objection to the specification set forth in the office action mailed on Jun. 28, 2005, paragraph 2, has been withdrawn in response to the filing of the substitute specification on Sep. 28, 2005. The substitute specification capitalizes the

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trademarks disclosed in the specification.

The rejection of claims 3 and 7 under 35 U.S.C. 102(b) as being anticipated by US 5,753,399 (Hayase), set forth in the office action mailed on Jun. 28, 2005, paragraph 6, has been withdrawn in response to the amendments to claims 3 and 7 set forth in the amendment filed on Sep. 28, 2005. Those amendments to claims 3 and 7 add the limitation that the image-forming apparatus comprises the toner according to claims 1 or 2 or the toner according to any one of claims 4 to 6, respectively. Hayase does not teach or suggest an electrophotographic image forming apparatus comprising the toner recited in instant claims 3 and 7.

The rejection of claims 1-7 under 35 U.S.C. 102(b)/103(a) over US 2002/0051924 A1 (Iida), as evidenced by applicants' admissions, set forth in the office action mailed on Jun. 28, 2005, paragraph 7, has been withdrawn in response to the amendment to claims 1 and 4 set forth in the amendment filed on Sep. 28, 2005. Those amendments to claims 1 and 4 add the limitation that the binder resin comprises a block polyester and an amorphous polyester. As noted by applicants in the response filed on Sep. 28, 2005, page 8, Iida does not teach or suggest such a binder resin as recited in the instant claims.

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4. The disclosure is objected to because of the following informalities:

The substitute specification filed on Sep. 28, 2005, does not incorporate the amendment filed on Feb. 27, 2004, at page 8, line 20. That amendment corrected the second occurrence of figure number "1" to -- 2 --.

Appropriate correction is required.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 3 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 7 are indefinite in the phrase "{a]n image-forming apparatus comprising . . . a toner" because it is not clear what is the structural relationship between the apparatus and the toner. It is not clear how an apparatus comprises a toner. A toner is not a structural element of an apparatus, such as a charging device; it is merely a material or an article

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that is worked upon by the apparatus. The claims do not recite any structural relationship between the apparatus and the toner.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1, 4, and 5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 02/084408 A1 (Matsumura), as evidenced by applicants' admissions at page 5, lines 2-9 and 14-19, page 76, lines 1-12, page 77, lines 1-5, 7-9, 11-14, 16-17, and 20-22, page 88, lines 1-12, page 88, line 25, to page 89, line 12, and page 90, lines 5-6, 12-13, and 20-21, of the originally filed specification; and Tables 1A and 1B at pages 75 and 87,

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respectively, of the originally filed specification (applicants' admission I).

US 2004/0132920 A1 (US'920), filed under 35 U.S.C. 371, is the national stage of the WO application of Matsumura, and therefore is presumed to be an accurate English-language translation of the WO application of Matsumura. 35 USC 371(c)(2), 372(b), and 365(c). See US'920, the translation of Matsumura, for cites.

Matsumura discloses a toner comprising 100 parts by weight of toner particles comprising a polyester binder resin and a colorant. The polyester binder resin comprises two components: (1a) 15 parts by weight of a block polyester copolymer; and (2a) 85 parts by weight of a non-crystalline, i.e., amorphous polyester resin. US'920, paragraphs 0309-0310, and example 19 at paragraphs 0311 and in Table 7 at page 28. The polyester binder resin meets the binder resin limitations recited in instant claims 1 and 4. Matsumura discloses that the binder resin is colorless and transparent. Table 7, example 19. According to Matsumura, when the block polyester copolymer (1a) and the non-crystalline polyester resin (2a) are compatible, the resultant binder resin is colorless. US'920, paragraph 0139. Matsumura further discloses a fixing device which fixes an unfixed toner image on a recording medium where the toner image

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is formed from the toner in example 19 of Matsumura. US'920, paragraphs 0284-0285 and Table 7, example 19.

Matsumura does not disclose that the toner has the storage modulus properties recited in instant claims 1, 4, and 5. However, Matsumura discloses that the toner exhibits a low temperature fixability of 115°C, and a region of no offset between 105 to greater than 210°C, i.e., a minimum non-offset temperature of 105°C. Table 7, example 19. These properties appear to be the same properties sought by applicants.

The originally filed specification at page 5, lines 2-9, discloses that an "object of a first aspect of the present invention . . . is to provide a toner which can effectively improve low temperature fixing stability and offset resistance of a toner by using dynamic viscoelastic characteristics more conformable for actual toner behavior in fixation by heating." The originally filed specification at page 5, lines 14-19, discloses that another "object [of] a second aspect of the present invention . . . is to provide a toner which can effectively improve fixing stability and offset resistance to a toner by using dynamic viscoelastic characteristics more conformable to actual toner behavior in fixation by heating."

The originally filed specification shows that in an oil-less fixing device, some toners that meet the storage modulus

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properties recited in instant claim 1 exhibited a low temperature offset and a "minimum temperature of good fixing rate" of 160°C or less; while other toners that meet the storage modulus properties recited in instant claim 1 exhibited a low temperature offset and a "minimum temperature of good fixing rate" of "higher than 160°C and lower than 180°C." See Table 1A at page 75 of the originally filed specification, examples 1A through 3A and 6A; the originally filed specification, page 76, lines 1-12; and page 77, lines 1-5, 11-14, and 20-22.

Toners that do not possess the storage modulus properties recited in instant claim 1 exhibited a low temperature offset and a "minimum temperature of good fixing rate" of 180°C or higher. See Table 1A, examples 5A and 7A; and page 76, lines 1-12; and page 77, lines 7-9 and 16-17.

The originally filed specification also shows that some toners that meet the storage modulus limitations recited in instant claims 4 and 5 exhibited a hot offset temperature of 200°C or higher and a "minimum temperature of good fixing rate" of 160°C or less; while other toners that meet the storage modulus limitations recited in instant claims 4 and 5 exhibited a hot offset temperature of "higher than 180°C and lower than 200°C" and a "minimum temperature of good fixing rate" of 160°C or less. See Table 1B at page 87 of the originally filed

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specification, examples 2B and 3B; page 88, lines 1-12; page 88, line 25, to page 89, line 2; and page 89, lines 7-10, and 16-18.

A toner that does not possess the storage modulus limitations recited in instant claims 4 and 5 exhibited a hot offset temperature of 200°C or higher and a "minimum temperature of good fixing rate" of 180°C or higher. See Table 1B at page 87, example 5B; and page 89, lines 1-12; page 90, lines 5-6, 12-13, and 20-21.

Thus, because the Matsumura toner meets the toner compositional limitations recited in the instant claims and because the Matsumura toner appears to provide the same properties sought by applicants, it is reasonable to presume that the Matsumura toner has the storage modulus properties recited in instant claims 1, 4, and 5. The burden is on applicants to prove otherwise. In re Fitzgerald, 205 USPQ 594 (CCPA 1980).

10. Claims 3/(1) and 7/(4,5) are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,748,192 B2 (Izawa) combined with Matsumura, as evidenced by applicants' admission I.

US'920, filed under 35 U.S.C. 371, is the national stage of the WO application of Matsumura, and therefore is presumed to be

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an accurate English-language translation of the WO application of Matsumura. 35 USC 371(c)(2), 372(b), and 365(c). See US'920, the translation of Matsumura, for cites.

Izawa discloses an electrophotographic image forming apparatus that meets the structural components recited in instant claims 3 and 7, but for the particular toner. The apparatus shown in Fig. 1 comprises a photosensitive drum **1**, i.e., an image carrier on which an electrostatic latent image is formed, a charging roller **2**, an exposure unit **3**, a developing unit **4** that comprises a toner, a transfer device **5**, and a heat-pressure fixing unit **6**. The heat-pressure fixing unit **6** comprises a heating roller **10** and a pressure roller **20**, which fixes a toner image to a recording medium. According to Izawa, the fixing unit is effective for oilless fixing. Figs. 1 and 2; col. 6, line 28, to col. 7, line 10; and col. 17, lines 57-58.

Izawa does not exemplify the particular toners recited in the instant claims. However, Izawa does not limit the type of toner used.

Matsumura discloses a toner as described in paragraph 9 above, which is incorporated herein by reference. The Matsumura toner meets the toner compositional limitations and the storage modulus properties recited in instant claims 3/(1) and 7/(4,5). According to Matsumura, the toner exhibits excellent low-

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temperature fixation performance, high-temperature offset-resistance and anti-blocking performance. The toner also provides satisfactory color development. Paragraph 0016 and Table 7, example 19.

It would have been obvious for a person having ordinary skill in the art, in view of the teachings of Matsumura, to use the toner disclosed by Matsumura as the toner in the developing unit of the image forming apparatus disclosed by Izawa. That person would have had a reasonable expectation of successfully obtaining an electrophotographic image forming apparatus that is capable of forming toner images that have the properties disclosed by Matsumura.

11. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by US 2005/0100807 A1 (Yamazaki), as evidenced by applicants' admissions I.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the

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invention "by another," or by an appropriate showing under 37 CFR 1.131.

Yamazaki discloses a toner comprising 100 parts by weight of a polyester binder resin, a colorant, and 2 parts by weight of carnauba wax, i.e., a release agent. See paragraphs 0383-0398; and example 11 at paragraph 0411 and in Table 1 at page 31. The polyester binder resin comprises two components: 15 parts by weight of polyester block copolymer B'; and 85 parts by weight of amorphous polyester resin A. The amount of carnauba wax is within the releasing agent amount recited in instant claims 2 and 6. The polyester binder resin meets the polyester binder resin limitations recited in instant claims 1 and 4. Yamazaki further discloses an image-forming apparatus that comprises a photosensitive drum **30**, i.e., an image carrier on which an electrostatic latent image is formed, a charging device **40**, an exposure device **50**, developing units **60Y**, **60C**, **60M**, and **60K**, intermediate transfer device **70**, and a fixing unit **190**. The fixing device comprises a fixing roller **210** and a pressing roller **220**. Fig. 5, paragraphs 0307-0319. Yamazaki further discloses that the fixing unit comprises releasing members **310** and **320** for the fixing roller and the pressing roller. The releasing members comprise a resin sheet or a metal sheet, where the releasing

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member for the fixing roller is coated with a fluorocarbon resin. Figs. 7 and 8, and paragraphs 0324-0327

Yamazaki does not explicitly disclose that the two rollers in the fixing unit are "oil-less" as recited in instant claims 3 and 7. However, Yamazaki does not disclose that a release oil is applied to the fixing rollers. Nor does Yamazaki disclose that the fixing unit comprises a release oil applicator. Thus, it is reasonable to conclude that the Yamazaki fixing roller and the pressing roller are "oil-less" as recited in the instant claims. The burden is on applicants to prove otherwise.

Fitzgerald, supra. Accordingly, the structural components in the Yamazaki apparatus meet the structural components recited in instant claims 3 and 7.

Yamazaki does not disclose that the toner has the storage modulus properties recited in instant claims 1, 4, and 5. However, Yamazaki discloses that in its fixing device, the toner exhibits good fixability for a temperature range of 120-210°C with no occurrence of offset. Yamazaki, paragraph 0437 and Table 3, example 11. These properties appear to be the same properties sought by applicants.

The originally filed specification at page 5, lines 2-9, discloses that an "object of a first aspect of the present invention . . . is to provide a toner which can effectively

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improve low temperature fixing stability and offset resistance of a toner by using dynamic viscoelastic characteristics more conformable for actual toner behavior in fixation by heating."

The originally filed specification at page 5, lines 14-19, discloses that another "object [of] a second aspect of the present invention . . . is to provide a toner which can effectively improve fixing stability and offset resistance to a toner by using dynamic viscoelastic characteristics more conformable to actual toner behavior in fixation by heating."

The discussion of applicants' admissions in paragraph 9 above is incorporated herein by reference.

Thus, because the Yamazaki toner in example 11 of Yamazaki meets the toner compositional limitations recited in the instant claims and because the Yamazaki toner appears to provide the same properties sought by applicants, it is reasonable to presume that the Yamazaki toner in example 11 of Yamazaki has the storage modulus properties recited in instant claims 1, 4, and 5. The burden is on applicants to prove otherwise.

Fitzgerald, supra.

12. Claims 1 and 2 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application

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No. 10/787,147 (Application'147), as evidenced by that portion of the disclosure in Application'147 that supports the subject matter claimed in Application'147, and applicants' admissions in examples 2A to 4A and Fig. 2 of the instant specification.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed subject matter in Application'147 renders obvious the toner recited in the instant claims.

Reference claim 1 recites a toner comprising a binder resin and at least a colorant and having a variation of its "storage modulus ( $G' (NL)$ ) in a nonlinear region at 180°C during 200 seconds, in step strain measurement of from a linear region to a nonlinear region of viscoelastic characteristics, of from 12 to 100 dyn/cm<sup>2</sup>." Reference claim 3, which depends on reference claim 1, requires that the toner further comprise a releasing agent in an amount of 4 parts by weight or less per 100 parts by weight of binder resin, which meets the toner composition limitation recited in instant claim 2.

Reference claim 5 recites a toner comprising a binder resin and at least a colorant and having a "loss modulus ( $G''(NL)$ ) in a

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nonlinear region at 180°C, in step strain measurement of from a linear region to a nonlinear region of viscoelastic characteristics, of from 1,000 to 4,000 dyn/cm<sup>2</sup>." Reference claim 6, which depends on reference claim 5, requires that the toner comprise a releasing agent in an amount of 4 parts by weight or less per 100 parts by weight of binder resin, which meets the toner composition limitation recited in instant claim 2.

The claims of Application'147 do not recite that the toner has a "storage modulus ( $G'(L1)$ ) in a linear region and a storage modulus ( $G'(NL)$ ) in a nonlinear region at 180°C, in a step strain measurement of from a linear region to a nonlinear region of viscoelastic characteristics, satisfying the relationships of  $G'(L1)/G'(NL)$  is from 5 to 20, and  $G'(NL)$  is from 100 to 400 dyn/cm<sup>2</sup>" as recited in instant claim 1. Nor do the reference claims recite that the binder resin comprises a block polyester and an amorphous polyester. However, that portion of Application'147 that supports the toners recited in references claims 1, 3, 5, and 6 exemplifies toners that appear to be identical to the toners exemplified in the instant specification that support the toners recited in instant claims 1 and 2. Compare Application'147 toners 5A, 1B, 2B, and 5B, with the instant specification toners 3A, 2A, 3A, and 4A, respectively.

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In addition, Fig. 3 in Application'147 shows "an example of the behavior of the toner of the present invention having dynamic viscoelasticity of temperature-dependency before fixing nip [,] at fixing nip part, and at the outlet of fixing nip of a heating fixing unit" that appears to be identical to Fig. 2 of the instant specification. Fig. 2 of the instant specification shows the dynamic viscoelasticity characteristics of an example of the instant invention. Fig. 3 of Application'147 shows that the toners claimed in Application'147 have the same storage modulus characteristics as the toners recited in the instant claims. When addressing the use of whether a claim in the application defines an obvious variation of an invention claimed in a patent, "those portions of the specification which support the patent claims may also be examined and considered." See MPEP 804,II.B.1, pp. 800-22 to 800-23, citing In re Vogel, 164 USPQ 619, 622 (CCPA 1970). Thus, because the toners disclosed in Application'147 that support the toners claimed in Application'147 have the same composition as the toners that support the toners recited in instant claims 1 and 2 disclosed in the instant specification, it is reasonable to presume that the toners claimed in Application'147 have the storage modulus properties recited in instant claims 1 and 2 and the binder resin recited in instant claim 1. In other words, the two set

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of toners appear to be the same material. The burden is on applicants to prove otherwise. Fitzgerald, supra.

It would have been obvious for a person having ordinary skill in the art, in view of the subject matter claimed in Application'147 and that portion in Application'147 that supports the subject matter claimed in Application'147, to make and use a toner as recited in the instant claims 1 and 2 because that person would have had a reasonable expectation of successfully obtaining a toner that is capable forming toned images.

13. Claims 4-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/787,147 (Application'147), as evidenced by that portion of the disclosure in Application'147 that supports the subject matter claimed in Application'147, and applicants' admissions in examples 2B and 3B and Fig. 2 of the instant specification.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed

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subject matter in Application'147 renders obvious the toner recited in the instant claims.

Reference claims 1 and 5 recite toners as described in paragraph 9 above, which is incorporated herein by reference. Reference claims 3 and 6, which depend from reference claims 1 and 5, respectively, require that the toner further comprise a releasing agent in an amount that is within the range recited in instant claim 6.

The claims of Application'147 do not recite that the toners have a "storage modulus ( $G'(L2)$ ) in a linear region at 180°C, in a step strain measurement of from a nonlinear region to a linear region of viscoelastic characteristics, of from 400 to 2,000 dym/cm<sup>2</sup>" as recited in instant claim 4. Nor do the claims of Application'147 recite that the toners have a ratio of the "storage modulus ( $G'(L2)$ ) to the storage modulus ( $G'(NL)$ ) in a strain measurement of from a nonlinear region to a linear region of viscoelastic characteristics, of from 3 to 8" as recited in instant claim 5. Nor do the reference claims recite that the binder resin comprises a block polyester resin and an amorphous polyester. However, that portion of Application'147 that supports the toners recited in references claims 1, 3, 5, and 6 exemplifies toners that appear to be identical to the toners exemplified in the instant specification that support the toners

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recited in instant claims 4-6. Compare Application'147 toners 2A, 5A, and 2B with the instant specification toners 2B and 3B, respectively. In addition, Fig. 3 in Application'147 shows "an example of the behavior of the toner of the present invention having dynamic viscoelasticity of temperature-dependency before fixing nip [,] at fixing nip part, and at the outlet of fixing nip of a heating fixing unit" appears to be identical to Fig. 2 of the instant specification. Fig.2 of the instant specification shows the dynamic viscoelasticity characteristics of an example of the instant invention. Fig. 3 of Application'147 shows that the toners recited in the claims in Application'147 have the same storage modulus characteristics as the toner recited in the instant claims. When addressing the use of whether a claim in the application defines an obvious variation of an invention claimed in a patent, "those portions of the specification which support the patent claims may also be examined and considered." See MPEP 804,II.B.1, pp. 800-22 to 800-23, citing In re Vogel, 164 USPQ 619, 622 (CCPA 1970). Thus, because the toners disclosed in Application'147 that support the toners claimed in Application'147 have the same composition as the toners disclosed in the instant specification that support the toners recited in instant claims 4-6, it is reasonable to presume that the toners claimed in Application'147

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have the storage modulus properties recited in instant claims 4-6 and the binder resin recited in instant claim 4. The burden is on applicants to prove otherwise. Fitzgerald, supra.

It would have been obvious for a person having ordinary skill in the art, in view of the subject matter claimed in Application'147 and that portion in Application'147 that supports the subject matter claimed in Application'147, to make and use a toner as recited in the instant claims 4-6 because that person would have had a reasonable expectation of successfully obtaining a toner that is capable forming toned images.

14. Applicants' arguments filed on Sep. 28, 2005, with respect to the obviousness-type doubling patenting rejections set forth in paragraphs 12 and 13 above have been fully considered but they are not persuasive.

Applicants state that because these rejections are provisional, applicants choose to postpone responding to those rejections until the time at which either application issues as a patent.

Because applicants did not provide any arguments traversing the rejections, the rejections set forth in paragraphs 12 and 13 stand.

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15. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The central fax phone number is (571) 273-8300.

Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on

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access to the Private PAIR system, contact the Electronic  
Business Center (EBC) at 866-217-9197 (toll-free).

JLD

Dec. 12, 2005

*Janis L. Dote*  
JANIS L. DOTE  
PRIMARY EXAMINER  
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1700